

### **REMARKS**

In the Office Action, the Examiner rejected claims 1-28. By this response, Applicants amend claim 25 and add claim 29 for clarification of certain features to expedite allowance of the present application. These amendments do not add any new matter. Upon entry of these amendments, claims 1-29 remain pending in the present application and are believed to be in condition for allowance. In view of the foregoing amendments and the following remarks, Applicants respectfully request reconsideration and allowance of all pending claims.

### **Objection to the Drawings**

In the Office Action, the Examiner objected to the drawings under 37 C.F.R. § 1.83(a). The Examiner specifically stated that the finger guard must be shown or the feature(s) canceled from the claim(s). Applicants respectfully traverse this rejection. FIGS. 3 and 4 of the drawings include a guard 86. *See* Specification [0020]. In light of the disclosed feature, Applicants assert that the drawings show every feature of the invention specified in the claims. However, as set forth above, Applicants hereby amend paragraph [0020] to correlate the guard 86 with the finger guard as recited in the original claim 25. This amendment does not add any new matter to the present application. In view of this amendment, Applicants respectfully request withdrawal of the Examiner's objection to the drawings.

### **Claim Rejections under 35 U.S.C. § 112, First Paragraph**

The Examiner rejected claims 1, 2, 3, 4, 9, 13, 20, 25, and 28 under 35 U.S.C. § 112, first paragraph for failing to comply with the enablement requirement. Applicants respectfully traverse this rejection.

### ***Legal Precedent and Guidelines***

Regarding the enablement requirement, the Examiner has the initial burden to establish a *reasonable basis* to question the enablement provided for the claimed

invention. *In re Wright*, 999 F.2d 1557, 1562, 27 U.S.P.Q.2d 1510, 1513 (Fed. Cir. 1993). The test for enablement, as set forth by the Supreme Court, is whether the experimentation needed to practice the invention is undue or unreasonable? *Mineral Separation v. Hyde*, 242 U.S. 261, 270 (1916). A patent need not teach, and preferably omits, what is well known in the art. *In re Buchner*, 929 F.2d 660, 661, 18 U.S.P.Q.2d 1331, 1332 (Fed. Cir. 1991). The *undue experimentation* test essentially evaluates whether one of reasonable skill in the art can make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation. *U.S. v. Telectronics, Inc.*, 857 F.2d 778, 785, 8 U.S.P.Q.2d 1217, 1223 (Fed. Cir. 1988). As long as the specification discloses at least one method for making and using the claimed invention that bears a *reasonable correlation* to the entire scope of the claim, then the enablement requirement of section 112 is satisfied. *In re Fisher*, 427 F.2d 833, 839, 166 U.S.P.Q. 18, 24 (C.C.P.A. 1970). The specification need not contain an example if the invention is otherwise disclosed in such manner that one skilled in the art will be able to practice it without an undue amount of experimentation. *In re Borkowski*, 422 F.2d 904, 908, 164 U.S.P.Q. 642, 645 (C.C.P.A. 1970).

### ***Deficiencies of Rejections***

In the Office Action, the Examiner specifically stated:

The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Applicant describes in the specification that the height of the blades (“H<sub>B</sub>”) is limited by the diameter of inner cylindrical portion 74 of the fan housing 70 and the hub diameter (“D<sub>H</sub>”) of the fan impeller 72. Applicant also talks about how the blade height that is 25% of the impeller diameter displaces greater amount of air.

Applicant fails to properly describe the blade height (“H<sub>B</sub>”) and the full blade height, since the hub is round in shape and the blades are

concave in shape at the point of contact to the hub the height of the blades (“H<sub>B</sub>”) will be different at various points along the hub diameter.

Similarly, with respect to the maximum chord length, applicant has managed to provide the definitions of chord but has failed to describe the maximum chord length and the blade height that corresponds to the maximum chord length. The mark-ups shown in the drawings will differ from point to point and do not precisely define different heights claimed by the applicant.

Applicant claims that the finger guard being displaced outward relative to the fan housing and also that the fan housing comprises a top that extends over each finger guard. These two conditions as described in the claim contradict each other, the first one suggests that the finger guard is outside with respect to the fan housing and the second one suggests that the finger guard as the top of the fan housing that extends over the finger guard is still a part of the fan housing.

Office Action, Pages 3-4.

With respect to the blade height (“H<sub>B</sub>”), Applicants direct the Examiner’s attention to Figure 6 and paragraph [0028] of the original application which show and discuss the blade height (“H<sub>B</sub>”). Furthermore, Applicants respectfully assert that one of ordinary skill in the art would interpret “blade height” to mean the “maximum height of a blade” in instances where the blade is rounded in shape.

Similarly, with respect to the maximum chord length (“C<sub>2</sub>”) and the maximum chord length height (“H<sub>MCL</sub>”), Applicants direct the Examiner’s attention to Figure 7 and paragraph [0030] of the original application which show and discuss the maximum chord length (“C<sub>2</sub>”) and the maximum chord length height (“H<sub>MCL</sub>”). Furthermore, based on definitions of the term “chord” (as given in paragraph [0029] of the specification), Applicants respectfully assert that one of ordinary skill in the art would interpret “maximum chord length” to mean “the widest portion of a blade” and “maximum chord length height” to mean “height on the blade corresponding to the maximum chord length.”

Finally, Applicants do not necessarily agree with the Examiner's reasons for rejecting independent claim 25 based on perceived contradictions within the claimed subject matter. However, Applicants hereby amend independent claim 25 and add dependent claim 29 in an effort to clarify certain claimed features.

For at least these reasons, among others, Applicants respectfully request withdrawal of the rejections under Section 112, first paragraph.

**Claim Rejections under 35 U.S.C. § 103(a)**

In the Office Action, the Examiner rejected the claims 1-28 based on a large number of references in various combinations. As discussed in detail below, Applicants respectfully traverse these rejections due to (1) improper prior art; (2) missing features, (3) lack of evidence to combine the references, and (4) improper hindsight reconstruction.

Specifically, the Examiner formulated the following rejections:

1. The Examiner rejected claim 1 under 35 U.S.C. § 103(a) as being unpatentable over Von der Heide et al. (U.S. Patent No. 5,652,470, hereinafter "Von der Heide") in view of Yokozawa et al. (U.S. Patent No. 5,650,678, hereinafter "Yokozawa").
2. The Examiner rejected claims 2-4 under 35 U.S.C. § 103(a) as being unpatentable over Von der Heide in view of Yokozawa and further in view of Dehmer (U.S. Patent No. 1,755,633, hereinafter "Dehmer").
3. The Examiner rejected claims 5 and 6 under 35 U.S.C. § 103(a) as being unpatentable over Von der Heide in view of Yokozawa and further in view of Harvey (Foreign Patent GB 0324203.9, hereinafter "Harvey").
4. The Examiner rejected claims 7 and 8 under 35 U.S.C. § 103(a) as being unpatentable over Von der Heide in view of Yokozawa and further in view of Harmsen (U.S. Patent No. 5,184,938, hereinafter "Harmsen").

5. The Examiner rejected claim 10 under 35 U.S.C. § 103(a) as being unpatentable over Von der Heide in view of Yokozawa and further in view of Neely et al. (U.S. Patent No. 5,588,804, hereinafter “Neely”).
6. The Examiner rejected claims 11, 13, 14, 15, 16, 17, 19, 20, 21, 22, and 23 under 35 U.S.C. § 103(a) as being unpatentable over Von der Heide in view of Yokozawa and further in view of Dehmer, Harvey, and Harmsen.
7. The Examiner rejected claims 25 and 26 under 35 U.S.C. § 103(a) as being unpatentable over Von der Heide in view of Yokozawa and further in view of Herbert (U.S. Patent No. 5,445,215, hereinafter “Herbert”).
8. The Examiner rejected claim 27 under 35 U.S.C. § 103(a) as being unpatentable over Von der Heide in view of Yokozawa and further in view of Herbert and further in view of Dehmer, Harvey, and Harmsen.
9. The Examiner rejected claims 12 and 24 under 35 U.S.C. § 103(a) as being unpatentable over Von der Heide in view of Yokozawa and further in view of Dehmer, Harvey, and Harmsen and further in view of Seki (U.S. Publication No. 2004/0170501, hereinafter “Seki”).
10. The Examiner rejected claim 28 under 35 U.S.C. § 103(a) as being unpatentable over Von der Heide in view of Yokozawa and further in view of Herbert and further in view of Seki.
11. The Examiner rejected claim 18 under 35 U.S.C. § 103(a) as being unpatentable over Von der Heide in view of Yokozawa and further in view of Dehmer, Harvey, and Harmsen and further in view of Horng (U.S. Patent No. 3,989,978, hereinafter “Horng”).

### ***Legal Precedent and Guidelines***

The pending claims must be given an interpretation that is reasonable and consistent with the *specification*. See *In re Prater*, 415 F.2d 1393, 1404-05, 162 U.S.P.Q. 541, 550-51 (C.C.P.A. 1969) (emphasis added); see also *In re Morris*, 127 F.3d 1048, 1054-55, 44 U.S.P.Q.2d 1023, 1027-28 (Fed. Cir. 1997); see also M.P.E.P. §§ 608.01(o) and 2111. Indeed, the specification is “the primary basis for construing the claims.” See *Phillips v. AWH Corp.*, No. 03-1269, -1286, at 13-16 (Fed. Cir. July 12, 2005) (*en banc*). One should rely *heavily* on the written description for guidance as to the meaning of the claims. See *id.*

Interpretation of the claims must also be consistent with the interpretation that *one of ordinary skill in the art* would reach. See *In re Cortright*, 165 F.3d 1353, 1359, 49 U.S.P.Q.2d 1464, 1468 (Fed. Cir. 1999); M.P.E.P. § 2111. “The inquiry into how a person of ordinary skill in the art understands a claim term provides an objective baseline from which to begin claim interpretation.” See *Collegenet, Inc. v. ApplyYourself, Inc.*, 418 F.3d 1225, 75 U.S.P.Q.2d 1733, 1738 (Fed. Cir. 2005) (quoting *Phillips v. AWH Corp.*, 75 U.S.P.Q.2d 1321, 1326). The Federal Circuit has made clear that derivation of a claim term must be based on “usage in the ordinary and accustomed meaning of the words amongst artisans of ordinary skill in the relevant art.” See *id.*

The burden of establishing a *prima facie* case of obviousness falls on the Examiner. *Ex parte Wolters and Kuypers*, 214 U.S.P.Q. 735 (PTO Bd. App. 1979). In addressing obviousness determinations under 35 U.S.C. § 103, the Supreme Court in *KSR International Co. v. Teleflex Inc.*, No. 04-1350 (April 30, 2007), reaffirmed many of its precedents relating to obviousness including its holding in *Graham v. John Deere Co.*, 383 U.S. 1 (1966). In *Graham*, the Court set out an objective analysis for applying the statutory language of §103:

Under §103, the scope and content of the prior art are to be determined, differences between the prior art and the claims at issue are to be ascertained, and the level of ordinary skill in the pertinent art are to be resolved. Against this background the obviousness or non-obviousness of the subject matter is to be determined. Such secondary considerations as commercial success, long-felt but unresolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented. *KSR, slip op.* at 2 (citing *Graham*, 383 U.S. at 17-18).

In *KSR*, the Court also reaffirmed that “a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art.” *Id.* at 14. In this regard, the *KSR* court stated that “it can be important to identify a reason that would have prompted a person of ordinary skill in the

relevant field to combine the elements in the way the claimed new invention does ... because inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known.” *Id.* at 14-15. Traditionally, to establish a *prima facie* case of obviousness, the CCPA and the Federal Circuit have required that the prior art not only include all of the claimed elements, but also some teaching, suggestion, or motivation to combine the known elements in the same manner set forth in the claim at issue. *See, e.g., ASC Hospital Systems Inc. v. Montifiore Hospital*, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984) (holding that obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching or suggestion supporting the combination.); *In re Mills*, 16 U.S.P.Q.2d 1430, 1433 (Fed. Cir. 1990) (holding that the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination). In *KSR*, the court noted that the demonstration of a teaching, suggestion, or motivation to combine provides a “helpful insight” in determining whether claimed subject matter is obvious. *KSR, slip op.* at 14. However, the court rejected a *rigid* application of the “TSM” test. *Id.* at 11. In this regard, the court stated:

The obviousness analysis cannot be confined by a formalistic conception of the words teaching, suggestion, and motivation, or by overemphasis on the importance of published articles and explicit content of issued patents. The diversity of inventive pursuit and of modern technology counsels against limiting the analysis in this way. In many fields it may be that there is little discussion of obvious techniques or combinations, and it often may be the case that market demand, rather than scientific literature, will drive design trends. *Id.* at 15.

In other words, the *KSR* court rejected a rigid application of the TSM test which requires that a teaching, suggestion or motivation to combine elements in a particular manner must be explicitly found in the cited prior art. Instead, the *KSR* court favored a

more expansive view of the sources of evidence that may be considered in determining an apparent reason to combine known elements by stating:

Often, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art all in order to determine whether there was an apparent reason to combine in the known elements in the fashion claimed in the patent at issue. *Id.* at 14.

The *KSR* court also noted that there is not necessarily an inconsistency between the idea underlying the TSM test and the *Graham* analysis, and it further stated that the broader application of the TSM test found in certain Federal Circuit decisions appears to be consistent with *Graham*. *Id.* at 17-18 (citing *DyStar Textilfarben GmbH and Co. v. C.H. Patrick Co.*, 464 F.3d 1356, 1367 (2006) (“Our suggestion test is in actuality quite flexible and not only permits but *requires* consideration of common knowledge and common sense”); *Alza Corp. v. Mylan Labs, Inc.*, 464 F.3d 1286, 1291 (2006) (“There is flexibility in our obviousness jurisprudence because a motivation may be found *implicitly* in the prior art. We do not have a rigid test that requires a teaching to combine ... “)).

Furthermore, the *KSR* court did not diminish the requirement for objective evidence of obviousness. *Id.* at 14 (“To facilitate review, this analysis should be made explicit. See *In re Kahn*, 441 F.3d 977, 988 (CA Fed. 2006) (“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness”). As our precedents make clear, however, the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.”); see also, *In re Lee*, 61 U.S.P.Q.2d 1430, 1436 (Fed. Cir. 2002) (holding that the factual inquiry whether to combine references must be thorough and searching, and that it must be based on *objective evidence of record*).



When prior art references require a selected combination to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gained from the invention itself, i.e., something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination. *Uniroyal Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 U.S.P.Q.2d 1434 (Fed. Cir. 1988). One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). The Federal Circuit has warned that the Examiner must not, “fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.” *In re Dembiczak*, F.3d 994, 999, 50 U.S.P.Q.2d 52 (Fed. Cir. 1999) (quoting *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 U.S.P.Q. 303, 313 (Fed. Cir. 1983)).

It is improper to combine references where the references teach away from their combination. *In re Grasselli*, 713 F.2d 731, 743, 218 U.S.P.Q. 769, 779 (Fed. Cir. 1983); M.P.E.P. § 2145. Moreover, if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 U.S.P.Q. 349 (CCPA 1959); *see* M.P.E.P. § 2143.01(VI). If the proposed modification or combination would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984); *see* M.P.E.P. § 2143.01(V).

In addition, “it is well established that product claims may include process steps to wholly or partially define the claimed product.” *In re Luck*, 177 U.S.P.Q. 523, 525 (C.C.P.A. 1973). To the extent that “these process limitations distinguish the *product* over the prior art, they must be given the same consideration as traditional product characteristics.” *Id.* (emphasis in original). These claims are not product-by-process

claims. A product-by-process claim defines a product by laying out the method steps required to produce the product. *See Atlantic Thermoplastics Co. Inc. v. Faytex Corp.*, 23 U.S.P.Q.2d 1481, 1490 (Fed. Cir. 1992). This is far different from a mixed limitation or hybrid claim that includes a functional limitation, but does not define the product solely by method steps. The general rule for interpreting hybrid claims is that all limitations are to be given patentable effect. *See In re Angstadt*, 190 U.S.P.Q. 214, 217 (C.C.P.A. 1976).

In order to rely on equivalence as a rational supporting an obviousness rejection, the equivalency must be recognized in the prior art, and cannot be based on applicant's disclosure or the mere fact that the components at issue are functional or mechanical equivalents. *In re Ruff*, 256 F.2d 590, 118 U.S.P.Q. 340 (CCPA 1958); *see also* M.P.E.P. § 2144.06.

### **Improper Prior Art**

#### ***The Harvey reference is not prior art.***

As summarized above, the Examiner relied on the Harvey reference in rejections 3, 6, 8, 9, and 11. Specifically, these rejections correspond to claims 5-6, 11-24, and 27. However, the Harvey reference is not prior art.

Specifically, the Harvey reference does not qualify as prior art under any provision of 35 U.S.C § 102. The filing date of the present application is February 20, 2004. The Harvey U.S. patent application does not qualify as prior art under Section 102(e) because it was not filed in the United States until October 14, 2004, which is after the February 20, 2004, filing date of the present application. The October 15, 2003 filing date of the Harvey Great Britain application is not the priority date under Section 102(e), because the Harvey Great Britain application was not filed in the United States or in an international application designating the United States. *See* 35 U.S.C. § 102(e); M.P.E.P. § 706.02(f)(1). Accordingly, Applicants respectfully request removal of the Harvey reference.

Upon removal of the Harvey reference, the rejections corresponding to claims 5-6, 11-24, and 27 are moot and must be withdrawn. As a result, Applicants stress that claims 5-6, 11-24, and 27 are currently in condition for allowance.

### **Missing Features**

***The cited references, taken alone or in hypothetical combination, fail to teach or suggest features recited by independent claim 1.***

Turning to the claims, the present independent claim 1 recites, *inter alia*, “an impeller comprising a hub to house the three-phase DC motor and a plurality of blades extending from the hub, wherein the impeller has an impeller diameter and each blade has a blade height that is at least 25 % of the impeller diameter.”

The cited references, taken alone or in hypothetical combination, fail to teach or suggest each blade having a blade height of “at least 25% of the impeller diameter,” as recited by independent claim 1. The Examiner stated that “Yokozawa et al. discloses blades and impeller where the blades are at least 25% of the impeller diameter as seen in figure 1.” Office Action, page 5. The Examiner then marked up a copy of Fig. 1 of Yokozawa with the Examiner’s interpretation of the dimensions shown in Fig. 1. *Id.* However, Applicants note that proportions of features in drawings are not evidence of actual proportions when the drawings are not to scale. *See* M.P.E.P. § 2125. When the reference does not disclose that the drawings are to scale and is silent as to dimensions, arguments based on measurement of the drawing features are of little value. *See Hockerson-Halberstadt, Inc. v. Avia Group Int’l*, 222 F.3d 951, 956, 55 USPQ 2d 1487, 1491 (Fed. Cir. 2000). Here, Yokozawa does not explicitly state that Fig. 1 is to scale nor does it mention actual dimension values. Moreover, Applicants respectfully submit it is more reasonable than not to interpret the blade height in Yokozawa as being consistent with the 20% of impeller diameter value disclosed in Applicants’ specification as being the typical blade height in conventional DC motors. *See* Application, paragraph [0028]. Thus, Fig. 1 of Yokozawa does not teach a blade height of at least 25% of the impeller

diameter. In addition, the secondary references fail to obviate the deficiencies of Yokozawa.

In view of these deficiencies among others, the cited references, taken alone or in hypothetical combination, cannot render obvious the current independent claim 1 and its dependent claims.

***The cited references, taken alone or in hypothetical combination, fail to teach or suggest features recited by independent claims 11 and 20.***

The present independent claim 11 recites, *inter alia*, “a stagger angle that increases from the hub to the tip of the blade.” Similarly, the present independent claim 20 recites, *inter alia*, “manufacturing each blade with a stagger angle that increases from the base region of the blade to a tip of each blade.”

The Examiner rejected claims 11, 13, 14, 15, 16, 17, 19, 20, 21, 22, and 23 as obvious over Von der Heide in view of Yokozawa and further in view of Dehmer, Harvey, and Harmsen. All of these rejections rely on stagger angle features the Examiner identified within the Harvey reference. However, as discussed above, the Harvey reference is not prior art and must be withdrawn. The remaining references fail to teach or suggest the stagger angle feature.

In view of the removal of the Harvey reference and the deficiencies of the remaining references, Applicants stress that independent claims 11 and 20 and their dependent claims are currently in condition for allowance.

***The cited references, taken alone or in hypothetical combination, fail to teach or suggest features recited by independent claim 25.***

Amended independent claim 25 recites, *inter alia*, “the fan housing comprises a top that extends crosswise over the pair of finger guards and overhangs the flow path outside the pair of finger guards.”

The cited references, taken alone or in hypothetical combination, fail to teach or suggest the foregoing features of independent claim 25. In rejecting independent claim 25 under 35 U.S.C. § 103, the Examiner failed to address how the cited references teach or suggest an overhanging top piece of the fan housing. Moreover, Applicants find no mention of such an overhanging top piece of the fan housing in any of the cited references. Although Applicants do not intend or suggest that the specification should be read into the claims, Applicants submit that the specification provides context to the present claim language. For example, Applicants’ specification discloses:

As illustrated in FIG. 4, a gap 90 is provided between the impellers 72 of the two fans to enable the air 58 to stabilize before it enters the second fan 46, reducing air resistance further. As noted above, the amount of audible noise generated is reduced by reducing the resistance to air flow. The top 88 of each fan housing 70 has an overhang 92 that covers the gap 90 between the first fan 44 and the second fan 46 to prevent air from being diverted into the server 20, rather than to the second fan 46. Preferably, the impeller 72 of the idle fan is able to spin freely. The resistance to the flow of air of a non-operating fan is greater when the impeller 72 is locked than it is when the impeller 72 is able to spin freely.

See Application, FIG. 4; paragraph [0020] (emphasis added). Again, the cited references are clearly missing the “the fan housing comprises a top that extends crosswise over the pair of finger guards and overhangs the flow path outside the pair of finger guards,” as recited by claim 25. In view of these deficiencies among others, the cited references, taken alone or in hypothetical combination, cannot render obvious the current independent claim 25 and its dependent claims.

For at least these reasons, among others, Applicants respectfully request withdrawal of the rejections under 35 U.S.C. § 103.

#### **Lack of Evidence to Combine the References**

In addition, the Examiner has not shown objective evidence of the requisite motivation or suggestion to modify or combine the cited references to reach the present claims. As summarized above, the *KSR* court did not diminish the requirement for objective evidence of obviousness. *KSR*, *slip op.* at 14 (“To facilitate review, this analysis should be made explicit. See *In re Kahn*, 441 F.3d 977, 988 (CA Fed. 2006) (“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness”). As our precedents make clear, however, the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.”); see also, *In re Lee*, 61 U.S.P.Q.2d 1430, 1436 (Fed. Cir. 2002) (holding that the factual inquiry whether to combine references must be thorough and searching, and that it must be based on *objective evidence of record*). In the present rejection, the Examiner combined the cited references based on *conclusory and subjective statements*. Accordingly, Applicants respectfully request the Examiner to produce *objective evidence* of the requisite motivation or suggestion to combine the cited references, or remove the foregoing rejection under 35 U.S.C. § 103.

#### **Improper Hindsight Reconstruction**

The Examiner’s rejections also appear to be based on hindsight reconstruction. Referring to the rejections summarized above, the Examiner’s rejections are based on combinations of two references, three references, four references, five references, and even six references in some cases. The Examiner appears to be picking and choosing among various prior art references without regard to the requisite obviousness of making

such combinations. Instead, the Examiner appears to be using Applicant's disclosure and claims as a guide for hindsight reconstruction of the present claims. This hindsight reconstruction is clearly improper and cannot be used to formulate rejections under Section 103.

As discussed above, when prior art references require a selected combination to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gained from the invention itself, i.e., something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination. *Uniroyal Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 U.S.P.Q.2d 1434 (Fed. Cir. 1988). One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). The Federal Circuit has warned that the Examiner must not, "fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher." *In re Dembiczak*, F.3d 994, 999, 50 U.S.P.Q.2d 52 (Fed. Cir. 1999) (quoting *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 U.S.P.Q. 303, 313 (Fed. Cir. 1983)).

For at least this additional reason, Applicants respectfully stress that the present rejections (particularly rejections numbered 6, 8, 9, 10, and 11) are based on improper hindsight reconstruction and must be withdrawn.

### **New Claim**

As noted above, Applicants hereby add new claim 29. This new claim adds no new matter and is fully supported in Applicants' specification. Dependent claim 29 is believed allowable for its dependency from an allowable independent claim, as well as by virtue of the subject matter separately recited by this dependent claim.

**Conclusion**

Applicants respectfully submit that all pending claims should be in condition for allowance. However, if the Examiner believes certain amendments are necessary to clarify the present claims or if the Examiner wishes to resolve any other issues by way of a telephone conference, the Examiner is kindly invited to contact the undersigned attorney at the telephone number indicated below.

Respectfully submitted,

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